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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,222	03/03/2004	Walter L. Moden	3389.8US (97-0638.08/US)	4777
24247	7590	01/04/2005		EXAMINER
TRASK BRITT				TRINH, MINH N
P.O. BOX 2550				
SALT LAKE CITY, UT 84110			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/792,222	MODEN ET AL. <i>CR</i>
	Examiner	Art Unit
	Minh Trinh	3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 October 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 is/are pending in the application.
 - 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/3/04.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. Applicant's election without traverse of Species 1A, claims 1-3 in the reply filed on 10/18/04 is acknowledged. Thus, claim 4 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/18/04.

Specification

2. The title of the invention is not descriptive. A new title (method invention) is required that is clearly indicative of the invention to which the claims are directed.

3. The abstract should have been modified to read on the method invention.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,475,831 to Moden et al, hereinafter '831. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully claimed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

As applied to claim 1 and 3, The '831 claims a method for connecting a horizontal stacked plurality of primary integrated circuit packages (PICP's) on a substrate having a plurality of circuits thereon, each primary IC package having a plurality of outer leads and a plurality sides, using a cage having on open side comprising: providing a cage enclosing at least two sides of the plurality sides of each primary integrated circuit package (PICP) of the stacked plurality of PICP's; attaching the cage to the substrate, the cage connecting at least one outer lead to the plurality of outer leads of the stacked plurality of PICP's to at least one conductive bus of a plurality of spaced traverse conductive buses (compare claim 1).

As applied to claim 2, the '831 claims every aspect limitation of this claim (compare claim 6).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishino (5,343, 075).

Nishino discloses a method of the present invention comprising steps: providing a cage 11 enclosing at least two sides of the plurality sides of each primary integrated circuit package (PICP) of the stacked plurality of PICP's (see Fig. 1A, references 1a-d); attaching the cage 11 to the substrate 9, the cage connecting at least one outer lead to the plurality of outer leads of the stacked plurality of PICP's to at least one conductive bus 7 of a plurality of spaced traverse conductive buses 8 (see Fig. 1B and the discussed at col. 4). It is noted that reference 11 of Nishino represented the broadly claimed "cage" of the present invention.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishino. Nishino as modified above does not teach the more than two sides cage that associated with the method. However, it would have been an obvious matter of design choice to form a cage enclosing that have more than two sides since the exact number of sides

would solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the cage enclosing that having at least two sides as taught by Nishino references.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to duplicate of the essential parts of a device (i.e., forming a cage enclosing that having at least three sides instead of two), since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Prior Art References

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art references are cited for their teaching of a method for forming stacked IC packages or the like.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7307 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



M. Trinh
Primary Examiner Group 3729

mt
December 30, 2004